UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
MONTOYA, OSCHTA I

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 December 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-47</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-47</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/29/2008 has been entered.

Response to Arguments

2.   Applicant's arguments filed 12/29/2008 have been fully considered but they are not persuasive.

in response to applicant's argument that no where in Rhoads is described "integrating a delivered asset with a content stream", applicant should note that one of the references to this integration, on the instant application, is referring to storing the assets when certain constraints are met and allowing the user to use these assets in a seamless fashion, this is exactly what Rhoads teaches (col. 9, lines 30-45); the other reference to this integration is related to integrating an asset with streaming video in order to present the user with an uninterrupted and continuous stream of content and this is disclose by Rhoads (col. 20, line 40-67), when Rhoads discloses the synchronization of the asset and the streaming video.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads

et al., US 6,442,285.

Regarding claim 1, Rhoads discloses a method for delivering an asset over a

network for integration with a content stream (Fig. 1 and col. 3/line 61 to col. 4/line 14 as

the music is delivered over the internet to consumers) comprising:

supplying an asset list over said network to a user device(col. 25/line 50 to col. 26/line 7

as client process is a computer process of client computer connected to the user

device; and an asset list is the list of available media or music delivered to the user for

downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory

includes a data structure that serves as a look up table for searching and indexing

music songs in the user's online music library, Col. 16, lines 10-50); delivering an asset,

which is included in said asset list, over said network to said user device if a

predetermined constraint is satisfied (col. 9/line 45 to col. 10/line 21 as an example for

delivering of ordering music based on the user's constraint or authorization and/or

based on some other constraints, see col. 13/lines 35-52); and

integrating the delivered asset with said content stream (col. 9, lines 30-45, Col. 20,

lines 40-67).

Regarding claim 2, Rhoads discloses the method according to claim 1, wherein

said asset comprises at least one of an audio content, a video content, a text content, a

right to use license or a multimedia file (col. 8/line 49 to col. 9/line 25 for audio and text

data; and col. 12/line 59 to col. 13/line 11 for video and games etc.).

Regarding claim 3, Rhoads discloses the method according to claim 1, further

comprising, prior to said supplying said asset list, generating said asset list at least in

part in response to a request from said user device (col. 8/line 49 to col. 9/line 25 as the

user requests and downloads music over the internet to their own device and the device

has a memory includes a data structure that serves as a look up table for searching and

indexing music songs in the user's online music library, which suggests that the user

generates the asset list to the provider, Col. 16, lines 10-50)

Regarding claim 4, Rhoads discloses the method according to claim 1, wherein

said content stream is transmitted from a content web site (refer to col. 16/line 32 to col.

17/line 17 for an example of the user accesses a content web site using hypertext link

or URL for downloading the content to the user's device or col. 23/lines 43-50 for

another example, col. 16, lines 10-50).

Regarding claim 5, Rhoads discloses the method according to claim 1, wherein said predetermined constraint comprises at least one of said user device being idle, a network Quality of Service (QOS) of said network, or the bandwidth usage being below a predetermined operating level (col. 21/line 50 to col. 22/line 6 for QoS of content provider addressed).

Regarding claim 6, Rhoads discloses the method according to claim 1, wherein said predetermined constraint comprises at least one of said user device CPU usage, or memory usage in said user device being below predetermined operating levels (col. 13/lines 35-45 for quality issue of the user device addressed).

Regarding claim 7, Rhoads discloses the method according to claim 1, wherein the delivery of said asset, over said network to said user device includes delivering said asset in response to a request from said user device (col. 19/lines 15-40 as the content is delivered from the server to the user device, i.e., a computer or set top box, or television, audio appliances etc. according to the user's request or pay-for-content, col. 16, lines 10-61).

Regarding claim 8, Rhoads discloses the method according to claim 1, wherein said delivered asset is stored (col. 8/lines 38-48 as the data can be stored in memory or hard disk at the user's residence).

Regarding claim 9, Rhoads discloses the method according to claim 8, and

further comprising presenting the stored asset integrated with said content stream in

real time (col. 12/lines 47-58 for live events can also be recorded with a (hyper) link).

Regarding claim 10, Rhoads discloses the method according to claim 1, wherein

said predetermined constraint comprises at least in part a time of day (col. 9/lines 37-45

as the user can specify which time of the day to upload or update new content via the

internet).

Regarding claim 11, Rhoads discloses the method according to claim 8, and

further comprising determining said predetermined constraint from CPU usage of said

user device, a-bandwidth usage, a-local cache usage, or a user device activity timer

(col. 13/lines 35-45 for quality issue of the user device addressed, col. 8/lines 38-48 as

the data can be stored in memory or hard disk at the user's residence).

Regarding claim 12, Rhoads discloses the method according to claim 8, and

further comprising presenting a substitute asset integrated in real time with said content

stream, if said asset is unavailable at said user device (col. 12/line 47 to col. 13/line 12

for the user has more option to access to promo clips, so that the user has more choice

to have alternative content or option if one is unavailable).

Regarding claims 13-25, these claims for "a method for presenting to an user a

continuous and uninterrupted stream of content over the network, the method

comprising: supplying an asset list over the network to a client process, said client

process operating in a user device; delivering an asset, from a remote location, over the

network to the user device if a predetermined constraint is satisfied, wherein the asset

list comprises at least an indication of said remote location (user interaction or user's

request, see col. 16/line 51 to col. 17/line 17); and integrating the delivered asset with a

content stream being received by the user device from the remote location over the

network" are rejected for the reasons given in the scope of claims 1-12 with media

streams of content delivered over the Internet to the remote user/client (col. 9, lines 30-

45, col. 16, line 10-50, col. 25/line 25 to col. 26/line 56), not limited to the cited

paragraphs above, but also to the entire disclosure of Rhodes.

As for claims 26-42, these claims for "a system for presenting content over a

network, the system comprising: an asset list capable of being made available by a

content provider over the Internet to a client process (col. 25/lines 25-61 for HTML, IP

addresses of the Internet), said client process capable of operating in a user('s device);

an asset, capable of being made available from a remote location, over said network to

said user device if a predetermined constraint is satisfied, wherein said asset list

comprises at least an indication of said remote location and a content stream capable of

being made available to said user device from said remote location over said network

and capable of being integrated with said asset " are rejected for the reasons given in

the scope of claims 1-12 with media streams of content delivered over the Internet to

the remote client/user (col. 9, lines 30-45, col. 16, line 10-50, col. 25/line 25 to col.

26/line 56), not limited to the cited paragraphs above, but also to the entire disclosure of

Rhodes.

Regarding claim 43, Rhodes discloses "a method for presenting a stream of

content over a network, the method comprising: supplying an asset list by a content

provider over said network to a client process, said client process operating on a user

device; delivering an asset, from a remote location, over said network to said user

device if a predetermined constraint is satisfied, wherein said asset list comprises at

least an indication of said remote location; and integrating the delivered asset with a

content stream being received by said user device from said remote location over the

network; wherein said asset and said content stream are represented" (refer to claims

13-25 as noted above).

Regarding claim 44, Rhodes discloses "a system for receiving an asset over a

network, the system comprising: an asset list to be made available by a content

provider over said network to a client process, said client process operating in a user

device; an asset, to be made available from a remote location, over said network to

said user device if a predetermined constraint is satisfied, wherein said asset list

comprises at least an indication of said remote location; and an integrator tool for

integrating the asset with a content stream being received by the user device from the remote location over said network, wherein said predetermined constraint includes at least one of said user device being idle, the bandwidth usage being below a predetermined operating level, the time of day, the user device CPU usage, or memory usage being below predetermined operating levels" are rejected for the reasons given in the scope of claims 1-12 with media streams of content delivered over the Internet to the remote client/user (col. 25/line 25 to col. 26/line 56) not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

As for claim 45, Rhodes discloses a method for receiving an asset over a network (Fig. 1 and col. 3/line 61 to col. 4/line 14 as the music is delivered over the internet to consumers), comprising: delivering an asset list provide by a content provider over said network at a client (col. 25/line 50 to col. 26/line 7 as client process is a computer process of client computer connected to the user device; and an asset list is the list of available media or music delivered to the user for downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library); said client operating in a user device; and receiving said asset, corresponding to at least a portion of said asset list, over said network at user device if a predetermined constraint is satisfied (col. 9/line 45 to col. 10/line 21 as an example for delivering of ordering music based on the user's constraint or authorization and/or based on some other constraints, see col. 13/lines 35-52); wherein said predetermined

constraint is at least one of said user device being idle, the network Quality of Service

(QOS), the network bandwidth usage being below a predetermined operating level,

the user device CPU usage, or memory usage of said user device being below

operating levels (col. 21/line 50 to col. 22/line 6 for QoS of content provider addressed;

and col. 13/lines 35-45 for quality issue of the user device addressed); and receiving a

content stream wherein said asset and said content stream are to be integrated (col. 9,

lines 30-45, Col. 16, line 10 to col. 20 line 67).

As for claim 46, Rhodes discloses "a method for providing a home media library

to a user over a network, the method comprising: supplying an asset list by a content

provider over the network to a set-top box, the set-top box including a client process

which manages the delivery of assets; and delivering an asset, from a remote location,

over the network to the set-top box if a predetermined constraint is satisfied, as

indicated by said client process wherein said asset list comprises at least an indication

of said remote location" (refer to claims 1 and 13 with a set top box is included as one of

the user devices, col. 19/lines 30-40); and delivering a content stream, wherein said

asset and content stream are to be integrated (col. 9, lines 30-45, Col. 16, line 10 to col.

20 line 67).

As for claim 47, Rhodes teaches a method of receiving media assets (Fig. 1

and col. 3/line 61 to col. 4/line 14 as the music is delivered over the internet to

consumers) at a set-top box for storage and subsequent viewing (with a set top box is

included as one of the user devices, col. 19/lines 31-40), the method comprising the steps of:

receiving a media asset list from a content provider on said set top box, said media asset list comprising a list of media assets to be downloaded and information about the location of each of the media assets; running a client process on said set top box, wherein said client process is capable of reading said media asset list to determine what media assets to transfer to the set top box and wherein said client process is further capable of managing delivery of digital media assets based at least in part on predetermined constraints (See col. 23/ lines 51-65 for the address location, and col. 25/line 50 to col. 26/line 7 as client process is a computer process of client computer connected to the user device; and an asset list is the list of available media or music delivered to the user for downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library); downloading digital media assets from said content provider to said set top box if the predetermined constraints are satisfied; and storing the downloaded digital media assets on the set top box; (col. 8/line 38- 64 for user home music library which downloading music online or over the Internet; and col. 9/line 45 to col. 10/line 21 as an example for delivering of ordering music based on the user's constraint or authorization and/or based on some other constraints, see col. 13/lines 35-52); and integrating the stored assets with a content stream for viewing on a television or other display device (col. 9, lines 30-45, Col. 16, line 10 to col. 20 line 67).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oschta Montoya whose telephone number is (571)270-1192. The examiner can normally be reached on Monday/Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

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